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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,929	10/10/2006	Frederic Taran	279089US0PCT	6537
22850 7590 07/09/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER HAQ, SHAFIQTUL				
ART UNIT 1641		PAPER NUMBER		
NOTIFICATION DATE 07/09/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/551,929

Applicant(s)

TARAN ET AL.

Examiner

SHAFIQUH HAQ

Art Unit

1641

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-53 is/are pending in the application.
- 4a) Of the above claim(s) 30,32,36,39,41,46,47 and 53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-29,31,33-35,37,38,40,42-45,48,49,51 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-918)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/30/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Election-Restriction

1. Applicants' election without traverse of a first compound, a second compound and a compound Z in response to Election of species requirement of January 29, 2008 is acknowledged and entered. Claims 30, 32, 36, 39, 41, 46, 47 and 53 do not read on the elected species.

Accordingly, claims 30, 32, 36, 39, 41, 46, 47 and 53 are withdrawn from further consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Claims 27-29, 31, 33-35, 37, 38, 40, 42-45, 48, 49, 51 and 52 are examined on merits in this office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 28, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 28 recites "the reaction of Bossio *et al*" in line 28. It is unclear whether the term "reaction of Bossio *et al*" is a name of a chemical reaction or the term is used to refer to a reaction recited in a publication of Bossio *et al*. Clarification is required. If the term is intended to refer to a chemical reaction disclosed in a reference by Bossio *et al*, it is noted that the expression "reaction of Bossio *et al*" will renders the claim indefinite because the claim does not itself define the invention but rely on

external material and modern claim practice requires that the claim must stand alone to define the invention and incorporation into claims by express reference to the specification is not permitted (Ex parte Fressola, 27 USPQ 2d 1608). The omission of failing to describe the claimed invention would render the claim incomplete.

6. Claim 45 recites "determined by means of a single immunoassay" in last line. It is unclear what immunoassay method/steps of an immunoassay are intended by the term "single immunoassay". The "single immunoassay" method/steps are unclear.
7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 27-29, 31, 33-35, 37, 38, 40, 42-45, 48, 49 and 51-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The method of claim 27 is for screening the operating conditions of a coupling reaction of at least two functional group G_1 and G_2 by reacting compounds $E_1-X_1-G_1$ and $E_2-X_2-G_2$ having the functional group to provide the product Z having the formula $E_1-X_1-G_1-G_2-X_2-E_2$ and determining the concentration of the product Z by an antibody recognizing E1. However, the method steps as claimed in claim 27 will not be able to determine the concentration of product Z because the reaction mixture as recited in the claim would contain reaction product Z as well as unreacted first

compound $E_1-X_1-G_1$ and unreacted second compound $E_2-X_2-G_2$, all of which would react with the antibody AC_1 (note that AC_1 can form covalent bond with E_2 in the presence of a coupling agent: see claim 27) and therefore, the method as recited would not be able to determine the concentration of compound Z without separation of the unreacted compounds from the reaction mixture.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shafiqul Haq whose telephone number is 571-272-6103. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Shibuya can be reached on 571-272-0806. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shafiqul Haq/
Primary Examiner, Art Unit 1641